



GOVERNMENT OF PUERTO RICO
DEPARTMENT OF STATE



February 16, 2023

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San Juan, PR 00917

SUBJECT MATTER
MARK

Office Action



CLASS
FILING NUMBER
FILING DATE
APPLICANT

012
248789-12-0
July 20th, 2022
DECATHLON

To whom it may concern:

In order to proceed with the examination of the said mark Applicant must submit the following information:

- ☒ 1. Clearly state the goods and/or services in connection with the mark as used or intended to be used in commerce in Puerto Rico. This applies if the Applicant customized the selection of goods or services.

The Application in reference includes a broad and indefinite description of the goods and/or services in which the trademark will be used. A written application must specify the particular goods and/or services on or in connection with which the applicant uses, or has a bona fide intention to use, the mark in commerce. To "specify" means to name in an explicit manner. The identification should set forth common names, using terminology that is generally understood. The identification of goods and/or services must be specific, definite, clear, accurate, and concise. *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296 (TTAB 1986), rev'd on other grounds, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *The Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), modified without opinion, 498 F.2d 1406, 181 USPQ 722 (C.C.P.A. 1974).

Applicant identifies and classifies the goods and/or services as follows:

- “Vehicles; apparatus for locomotion by land, engines for land vehicles; electric motors for bicycles, cycles; inner tubes for tires, repair outfits for inner tubes, adhesive rubber patches for repairing inner tubes; tires, skid devices for vehicle tires; anti-glare devices for vehicles; locks for vehicles; tarpaulins for baby carriages; luggage racks for vehicles; child safety seats for vehicles; covers for vehicles and saddle covers; covers for vehicle seats; hubs; gearing for land vehicles and horns; crutches cycles, bicycles; bicycles; frames; panniers frames, handlebar bags, saddle bags, bottle cages, all these goods for bicycles and cycles; brakes, handlebars, direction indicators, pedals, pumps, spokes, saddles; mudguards, tubeless tires for cycle; cycles forks; shock absorbers; bike racks; panniers for bicycles; locks for cycles; cranks; bicycle trailers” in International Class 012.

The wording in the identification of goods and/or services needs clarification because it is too broad and could include goods and/or services classified in other international classes. Applicant must clarify the identification of goods and/or to specify the nature of the goods as well as their main purpose and their particular field of use or channels of trade. The applicant may aid in clarifying the indefinite term by following the indefinite subject matter with “namely, [specify goods and/or services by generic or common commercial name and field of use].” Any modification to this wording must identify goods and/or services in properly classified in the original International Class specified in the application for these goods and/or services.

Applicant may substitute the following wording:

- **“Land vehicles; apparatus for locomotion by land, namely, motor scooters; engines for land vehicles; electric motors for bicycles and cycles; inner tubes for tires; repair outfits for inner tubes comprising tire repair patches; adhesive rubber patches for repairing inner tubes; tires; non-skid chains for vehicle tires; anti-glare devices for vehicles, namely, windshield visors; motor vehicle power locks; fitted covers for baby carriages; luggage racks for vehicles; child safety seats for vehicles; fitted covers for vehicles and bicycle saddle covers; fitted covers for vehicle seats; hubs for vehicle wheels; gearing for land vehicles and horns for vehicles; kickstands for cycles and bicycles; bicycle frames; bicycles; panniers adapted for bicycle; handlebar bags for bicycles; saddle bags for bicycles; water bottle cages for bicycles and cycles; brakes for bicycles; handlebars; direction indicators being directional signals for vehicles; bicycle pedals; bicycle pumps; bicycle spokes; bicycle saddles; mudguards; tubeless tires for cycle; bicycle forks; shock absorbers for bicycles; bike racks for vehicles; panniers for bicycles; locks for cycles; cranks for bicycles; bicycle trailers” in International Class 012; if accurate.**

Be advised that this amendment is illustrative and not exhaustive.

The Applicant is referred to the International Classification of Goods and Services under the Nice Agreement provided by the World Intellectual Property Organization for assistance in describing the specific goods in relation to which the Applicant uses the mark in commerce. For a list of the latest Nice Classification of goods you can access the following website:

<http://www.wipo.int/classifications/nivilo/nice/index.htm?lang=EN>

Please note that, while an application may be amended to clarify or limit the identification of services,

adding to or broadening the scope of the services is not permitted. Therefore, applicant may not amend the identification to include any services that are not within the scope of the services set forth in the present identification.

- ☐ 2. Provide a drawing of the mark as used or as intended to be used in commerce in Puerto Rico.
- ☐ 3. Provide a detailed description of the mark as used or as intended to be used in commerce in Puerto Rico.
- ☐ 4. Provide a specimen that shows the mark in connection with the goods or services identified in your application.
- ☐ 5. Applicant must disclaim those terms or components of the mark which are not susceptible of exclusive appropriation.
- ☐ 6. The registration for the applied mark is refused on the following grounds:
- ☐ 7. Other.

According to Rule 27 of Puerto Rico's Trademark Rules of Procedure, if the PRTTO does not receive a response to the abovementioned remarks within ninety (90) days, the Application shall be considered abandoned.

Note: Please refer to the name of the Examining Attorney. The office action response shall be filed online at <https://prtmfiling.f1hst.com/>. Please select "RESPUESTA A NOTIFICACION" from the dropdown menu. The cost of said filing is \$15.00. If any questions should arise, you can contact the Examining Attorney at jtorres@estado.pr.gov or marcas@estado.gobierno.pr

Cordially,



José M. Torres, Esq.
Examining Attorney
Puerto Rico Trademark Office